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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,616	11/02/2001	Joseph C. Salamone	P02360	5258
7590 Bausch & Lomb Inc. One Bausch & Lomb Place Rochester, NY 14604-2701			EXAMINER PENG, KUO LIANG	
			ART UNIT	PAPER NUMBER

1712

DATE MAILED: 12/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# **Office Action Summary**

Application No.

10/003,616

Applicant(s)

SALAMONE ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## **Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1, 6 and 10-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5, 7-9 and 15-24 is/are rejected.
- 7) ☒ Claim(s) 2-5, 7-9, 15-24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## **Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## **Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## **Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

### **DETAILED ACTION**

1. The Applicants' amendment filed on October 31, 2003 was received. Claims 2-5, 7-9, 15-18 and 20-23 are amended.
2. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action (Paper No. 8).

#### ***Claim Objections***

3. Claims 2-5, 7-9 and 15-24 are objected to because of the following informalities:

In Claim 2 (line 8), should "alkyl", "alkyloxy", "aryl" and "aryloxy" be -- alkylene --, -- alkyleneoxy --, -- arylene -- and -- aryleneoxy --, respectively?

In Claim 2, should there be at least one X or at least one R<sub>1</sub> containing aromatic moiety in order to be in consistent with "aromatic-based silyl monomers"?

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

4. Rejection of Claim 8 under 35 USC 112, second paragraph, is maintained because the rejection is adequately set forth in paragraph 6 of Paper No. 8.

***Claim Rejections - 35 USC § 102***

5. Rejection of Claims 2-5, 7-9 and 15-24 under 35 USC 102(b) as being anticipated by Takahashi (US 4 594 401) is maintained because the rejection is adequately set forth in paragraph 10 of Paper No. 8.

***Responsive to arguments regarding 35 USC § 112 rejection***

6. It is noted that Applicants did not address the issue regarding methyl methacrylate in Claim 8.

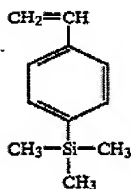
***Responsive to arguments regarding 35 USC § 102 rejection***

7. Applicant's arguments filed on October 31, 2003 have been fully considered but they are not persuasive.

*The Applicants' principal argument against the rejection is that "The monomer structure defined in the subject claims require an "X" group between a silyl moiety and a polymerizable group. TAKAHASHI does not disclose such a monomer or the use thereof. Rather, TAKAHASHI discloses the addition of trimethylsilylstyrene as a monomer to be copolymerized with hydrophilic monomers". (Remarks, page 10, last paragraph to page 11, first paragraph).*

It is noted that the aforementioned trimethylsilylstyrene

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does read on the aromatic-based silyl monomer of the present invention, wherein R is a polymerizable group of  $\text{CH}_2=\text{CH}-$ , X is a  $\text{C}_6$  arylene and  $\text{R}_1$  is a  $\text{C}_1$  alkyl. Note that the monomer has at least one non-phenyl  $\text{R}_1$  group (i.e., methyl group). Therefore, the present invention is still anticipated by Takahashi.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (703) 306-5550.

The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

klp  
December 3, 2003

  
Kuo-Liang Peng  
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